

REMARKS

In response to the Patent Office Letter of June 30, 2005, the Applicants respectfully request reexamination and reconsideration. To further the prosecution of this application, amendments and arguments are submitted herewith.

It is noted that this Office Action indicates that the application is now under final rejection. It is believed that this final rejection should be withdrawn. The primary reason for this request for withdrawal of the final action is that the Examiner never considered previously submitted claims 7-9. These claims should have been examined and in view of the non-examination of these claims it is requested that the finality of this rejection be withdrawn. Certainly, the next Office Action, if issued, should be non-final.

With regard to the substance of the Office Action, claims 1, 2 and 4-6 have been rejected by the Examiner under 35 U.S.C. §103(a) relying primarily upon the Casey '255 patent. The Applicant notes the Examiner's interpretation of that patent per attachment #1. The Examiner is clearly incorrect in his interpretation of the claimed first arcuate shaped portion, as allegedly illustrated by the "circles" in the attachment.

In this regard the Applicant also refers to page 5 of the Office Action and the Examiner's response. Quite simply, a "straight" section, as shown by the Casey '255 patent is not an "arcuate" portion. In accordance with the present invention, the upper jaw includes two arcuate portions and furthermore, the main claim recites that one arcuate portion has a greater radius of curvature than the other.

We note the Examiner's reference to "The History of Curvature." However, this is simply a technical treatise and the statement on page 4 should not be interpreted to mean that a straight section is somehow "arcuate." The ordinary meaning of the term "arcuate" in the context of the present invention is apparent from the specification and drawings. The ordinary meaning, such as taken from the Miriam Webster Online Dictionary, indicates something that is "curved like a bow." The ordinary meaning of the term "arcuate" is thus a curved or radiused portion and certainly not one that is straight. Accordingly, based upon the present existing claim language in

claim 1, and in particular the last three lines thereof, this rejection based upon the Casey patents should be immediately withdrawn.

The Examiner has also set forth a rejection of claims 1-3 under 35 U.S.C. §103(a) relying upon the Beroff et al. '694 patent and the Howell et al. '896 patent. Firstly, the clip of Beroff et al. is intended for use in a totally different manner to the clip of the invention, the clip of Beroff et al. is fitted using forceps and not via a cannula. Accordingly, the clip of Beroff et al. does not need to be openable upon dispensing from a magazine, as no magazine is used and there is no need or desire for it to have a small cross section in order to fit through a cannula with as small a diameter as possible. For this reason, there would be no motivation for the person skilled in the art to refer to the teaching of Beroff et al. when seeking to provide an improved clip for dispensing through a cannula.

Further, the capacity of the clips of Beroff et al. would be significantly less than the clips of the invention. The difference in capacity arises because, although the external surface of the leg 11 is an arc, the whole leg is not arcuate and therefore the inner surface of this leg 16 closes directly onto the inner surface 18 of the second leg. It is also arguable that the legs of Beroff et al. are not even elongate and that accordingly, the capacity of the clip is further reduced. The clips of Beroff et al. could not therefore be used to ligate anatomical structures as large as is possible with the inventive clips.

In addition, the text of column 5, line 22 makes clear that the curve of Beroff et al. is a single curve of constant radius, and not a complex shape formed from two arc of different radius. Moreover, the hook 14 in Beroff et al. does not form the second arcuate portion. This instead forms the latching part of the clip. For these reasons, the subject matter of the claims is inventive in view of Beroff et al. either alone or in combination with Howell et al.

Reference is now made to amendments in previous claims as well as new claims 10-20 that have been submitted herewith. The statement in claims 5 and 6 with regard to the "width" has now been clarified so that the width is as measured in the direction of the radius of curvature. Two minor corrections have been made in claim 9 to improve the definiteness of that claim.

Claims 10-22 have been added to this application. Claims 10-17 are all dependent claims relating directly or indirectly to claim 1 and should be allowable for the same reasons as previously stated in connection with the arguments set forth herein before. In addition, each of these dependent claims set forth additional features that are further clearly patentably distinguishing. For example, claim 11 defines the arcuate shaped portions as being contiguous. That certainly is not the case in connection with any of the prior art relied upon in the rejection presented by the Examiner.

The Applicant has also added a second independent claim to the application, namely claim 18. This claim contains significant portions of the subject matter of present claim 1 and additionally defines that the first arcuate shaped portion is contiguous with the second arcuate shaped portion and furthermore defines that the first arcuate shaped portion has a radius of curvature on at least its outer contact surface that is different than the radius of curvature of the second arcuate shaped portion which has a second radius of curvature. Claims 19-22 are dependent claims and should also be in condition for allowance.

CONCLUSION

In view of the foregoing amendments and remarks, the Applicants respectfully submit that all of the claims pending in the above-identified application are in condition for allowance, and a notice to that effect is earnestly solicited.

If the present application is found by the Examiner not to be in condition for allowance, then the Applicants hereby request a telephone or personal interview to facilitate the resolution of any remaining matters. Applicants' attorney may be contacted by telephone at the number indicated below to schedule such an interview.

Serial No. 10/031,218

Art Unit: 3731
Examiner: Bradford C. Pantuck

The U.S. Patent and Trademark Office is authorized to charge any additional fees incurred as a result of the filing hereof or credit any overpayment to our deposit account #19-0120.

Respectfully submitted,
Marcus Filshie et al., Applicants

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By: 

David M. Driscoll, Reg. No. 25,075
Applicant's Attorney
SALTER & MICHAELSON
321 South Main Street
Providence, Rhode Island 02903
Telephone: 401/421-3141
Facsimile : 401/861-1953
Customer No. 000987

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